

Remarks

This Application has been carefully reviewed in light of the Office Action mailed October 2, 2003. Applicant appreciates the Examiner's consideration of the Application. In order to clarify various aspects of Applicant's claims, Applicant has amended Claims 1-6. Additionally, Applicant has added new Claims 7-34. At least some of these amendments are not narrowing. None are considered necessary for patentability and none introduce new matter. Applicant respectfully requests reconsideration and allowance of all amended claims, and consideration and allowance of all new claims.

Claim Objections

The Examiner objects to Claim 1 because of informalities. Applicant has amended Claim 1 as requested by the Examiner to correct the typographical errors. Applicant respectfully requests that the Examiner withdraw the objections to Claim 1.

Claim 1 Complies with 35 U.S.C. § 112, Second Paragraph

The Examiner rejects Claim 1 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully disagrees.

In particular, the Examiner states that the phrase "resource constraints" renders Claim 1 indefinite. The Examiner argues that the phrase "resource constraints" is not defined by the claim, that the specification does not provide a standard for ascertaining the requisite degree, and that one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The test for indefiniteness under section 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." M.P.E.P. §2173.02 (citing *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986)). First, Applicant respectfully submits that resource constraints are well known to those of ordinary skill in the art, and that the phrase "resource constraints" is therefore definite as recited in Claim 1. Second, Applicant respectfully directs the Examiner's attention to at least page 10, lines 11-18 of Applicant's Specification, which discusses the idea that resources may be limited (which may operate as a constraint), and page 11, lines 4-13 of

Applicant's Specification, which provides an example discussion of resource allocation. Applicant respectfully submits that these example discussions are sufficient that those skilled in the relevant art would understand what is claimed when read in light of the specification.

For at least these reasons, Applicant respectfully submits that Claim 1 fully complies with 35 U.S.C. § 112, second paragraph. Thus, Applicant respectfully requests reconsideration and allowance of Claim 1.

Claims 1-3 Recite Patentable Subject Matter

The Examiner rejects Claims 1-3 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although Applicant believes Claim 1 recites patentable subject matter without amendment, Applicant has amended Claim 1 to further clarify that Claim 1 recites a computer-implemented method, performed using a computer system comprising one or more processing units and one or more memory units, and is directed to patentable subject matter. These clarifying amendments are not narrowing and do not introduce new matter. Applicant respectfully requests reconsideration and allowance of Claims 1-3.

Claims 1-6 are Allowable Over *Cherneff*

The Examiner rejects Claims 1-6 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent 6,233,493 to Cherneff, et al. ("*Cherneff*"). Applicant respectfully disagrees.

For example, *Cherneff* fails to disclose, teach, or suggest at least the following limitations recited in Claim 1, as amended:

- *using the computer system, for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product;*
- *using the computer system, generating a development schedule from the set of candidate products to maximize profit based at least on the determined impact that the time of introduction has on profits associated with each of the candidate products, the development schedule providing for product development in accordance with project definitions for each of the set of candidate products and resource constraints.*

Cherneff discloses a system for providing data representing an "optimal" product portfolio for use in enterprise product development planning. (Column 1, Lines 48-50) The system disclosed in *Cherneff* includes an optimizing engine that operates on an enterprise model using both a genetic algorithm and a constraint engine. (Column 1, Lines 50-53) The enterprise model includes product models (representing products proposed to be manufactured by the enterprise), component models (representing components from which products are made), task models (representing tasks to be performed in the development of a component), and resource models (representing resources available for use in performing tasks). (Column 1, Lines 53-59) The product models may include a projected total life-cycle sales as a function of the product's completion date, as well as a projected production cost that varies over time. (Column 3, Lines 30-32)

The genetic algorithm provides sequences of products as candidates for the portfolio, and the constraint engine builds a schedule for each sequence, subject to constraints of the model. (Column 1, Lines 59-62) The genetic algorithm and the constraint engine cooperate in an iterative process to evaluate each sequence in terms of constraint violations of constraints associated with the model, and to provide better sequences. (Column 1, Lines 62-66) The result of the process is a best portfolio, such as one that best satisfies constraints, and data representing a pipeline for developing the portfolio. (Column 1, Line 66-Column 2, Line 2) Constraint violations can be translated to an objective criteria (e.g., profit) such that the optimization is in terms of profit maximization. (Column 2, Lines 2-4)

However, while *Cherneff* discloses that the product models may include a projected total life-cycle sales as a function of the product's completion date, as well as a projected production cost that varies over time (Column 3, Lines 30-32), nowhere does *Cherneff* disclose, teach, or suggest, at a minimum, *"using the computer system, for each candidate product, determining based on the set of financial projections an impact that the time of introduction has on profits associated with the candidate product,"* as recited in Claim 1 as amended. Consequently, *Cherneff* also does not disclose, teach, or suggest, at a minimum, *"using the computer system, generating a development schedule from the set of candidate products to maximize profit based*

at least on the determined impact that the time of introduction has on profits associated with each of the candidate products, the development schedule providing for product development in accordance with project definitions for each of the set of candidate products and resource constraints," as recited in Claim 1 as amended.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and all claims that depend on independent Claim 1. For reasons similar to those discussed above with reference to independent Claim 1, Applicant respectfully requests reconsideration and allowance of independent Claim 4 and all claims that depend on independent Claim 4.

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from *Cherneff*. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. The example distinctions discussed by Applicant are sufficient to overcome the anticipation rejection.

New Claims 7-34 are Allowable

In addition to being dependent on allowable independent claims, new Claims 7-14 (which depend from independent Claim 1) and new Claims 15-22 (which depend from independent Claim 4) recite further patentable distinctions over the prior art of record.

For example, *Cherneff* does not appear to disclose, teach, or suggest that "at least one project definition comprises one or more phases for development of the candidate product associated with the at least one project definition, each phase comprising one or more of the plurality of ordered tasks," as recited in Claim 11. New Claim 19 recites similar limitations.

As another example, *Cherneff* does not appear to disclose, teach, or suggest "assigning a probability of completion to each of the one or more phases, the probability of completion for use in allocating resources when generating the development schedule in accordance with the project

definitions and the resource constraints," as recited in Claim 12. New Claim 20 recites similar limitations.

As another example, *Cherneff* does not appear to disclose, teach, or suggest "for each phase of product development, multiplying resources required for the phase by a product of the probability of completion for the phase and the probabilities of completion for all preceding phases," as recited in Claim 13. New Claim 21 recites similar limitations.

Furthermore, new Claims 23-33 are directed to software and are allowable for reasons similar to those discussed above with reference to Claims 1-3 and new Claims 7-14 (which Applicant has shown to be allowable). New Claim 34 is written in means-plus-function form and is allowable for reasons similar to those discussed above with reference to independent Claim 1 (which Applicant has shown to be allowable).

For at least these reasons, Applicant respectfully requests consideration and allowance of new Claims 7-34.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

The Commissioner is authorized to charge the amount of \$338.00 to cover the cost of one independent claim over three and fourteen claims total over twenty to Deposit Account No. 02-0384 of Baker Botts L.L.P. Although Applicant believes no other fees are due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Christopher W. Kennerly
Reg. No. 40,675

Date: January 2, 2004

Correspondence Address:

Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
Tel. (214) 953-6812